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At the time of the Office Action dated November 20, 2003, claims 1-27 were pending. In this Amendment, claims 1, 3, 4, 19, 20 and 24-27 have been amended, and claims 3, 4, 5-18, 22 and 23 have been cancelled. Care has been exercised to avoid the introduction of new matter. Specifically, claim 1 has been amended to include all the limitations recited in claim 2, revised slightly, and additional limitations supported by, for example, page 8, line 6 to page 9, line 4 of the specification. Claims 3, 4, 19, 20, 24, 25 and 27 have been amended for improving wording. In addition, claim 26 has been amended to eliminate lack of antecedent basis by dividing the claim into two claims. New claim 28 has been prepared as a result of the amendment of claim 26.

Claims 1-27 have been rejected under 35 U.S.C. §102(e) as being anticipated by Kuwano et al.

In the statement of the rejection, the Examiner asserted that Kuwano et al. discloses a system for storing, retrieving and transmitting documents using document IDs and document ID marks, identically corresponding to what is claimed.

It is well established that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

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Based on the above legal tenet and this Amendment, Applicants submit that Kuwano et al. does not disclose an image inputting and outputting apparatus including all the limitations recited in claim 1, and therefore, does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102.

Specifically, Kuwano et al. does not disclose that "dialog-type control means" is configured "for inquiring of a user if the reading of a document is completed or not, and giving a completion notice to said document management means," and "document management means is configured for, upon receipt of the completion notice, registering said document image data in the memory means by correlating the document image data with the document ID." Based on these limitations, the claimed invention can allow many sheets to be read into the apparatus, even when the sheets is too many to be read at once.

However, Kuwano et al. is silent as to the above limitations. The following is the Examiner's cited portion from Kuwano et al.

Upon completion of the printing of the last page of the first part (last page as order, but actually the 1st page) (namely, upon detection of the absence of any original remaining on the ADF 30), said image reading means 13 notifies to that effect to the registration & transfer means 20. At this notification, the registration & transfer means 20 reads out the documentary image data one after another from the final page of the documentary image data stored in the HDD 97 as above, and stores it in the memory 79 (steps S41 to S42). See page 6, paragraph [0110]; and Fig. 12.

According to the above portion, it is apparent that Kuwano's system does not include (a) means for inquiring of a user if the reading of a document is completed or not, (b) means for giving a completion notice to document management means, and (c) means for registering document image data in memory means upon receipt of the completion notice.

Further, Applicants submit that Kuwano et al. does not disclose an image inputting and apparatus including all the limitations recited in claims 19 and 20. Specifically, the following

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limitations, considered alone or in combination with other claim limitations, are not disclosed in the reference.

Claim 19: document management means for specifying document image data on the basis of a latest registration record or a latest fetching record for the document image data in the memory means, instead of the input of the document ID.

Claim 20: document management means configured for performing a first function to specify document image data on the basis of a latest registration record or a latest fetching record for the document image data in the memory means and configured for performing a second function to specify document image data on the basis of an inputted document ID corresponding to the document image data.

In relation to the above limitations, Applicants reproduce part of the Examiner's cited portions from Kuwano et al.

The registration & transfer means 20 either registers (stores) documentary image data obtained from the documentary image input means 1 on the HDD 97, or transfers documentary image data stored on the HDD 97 to specified equipment (laser printer B, FAX model 94, magneto-optic disc drive 99). The document ID encoding means 4 generates document ID at the time of documentary image input, the document ID decoding means 5 obtains document ID from the document ID mark to be described later, while the document management means 3 performs generation and control of attribute data corresponding to the respective documentary images registered on the HDD 97. See page 4, paragraph [0089].

Here, the user calls the document take-out picture as shown in FIG. 20 by selecting the "take out document" mode on the control panel 92, and specifies the method of input of document ID (input document ID based on document ID mark or input document ID in a sequence of characters), synthesis or not of document ID mark on the document taken out and the number of prints. Then the user presses the start key Ks. With this operation, the number of copies is set in the output t means 9. See page 8, paragraph [0154].

Applicants stress that it is apparent that Kuwano's system does not have any means for specifying document image data on the basis of a latest registration record or a latest fetching record of document image data to be fetched. Kuwano et al. discloses a document ID attached to a document image, but attaching such a document ID does not suggest using the latest registration or latest fetching of document image data to fetch the data.

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Therefore, Kuwano et al. does not identically describe an image inputting and outputting apparatus including all the limitations recited in claims 1, 19 and 20. Applicants, therefore, respectfully solicit withdrawal of the rejection of the claims.

Applicants further submit that a dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim. Therefore, claims 3, 4, 21 and 24-27 are patentable because they respectively include all the limitations of independent claims 1, 19 and 20. The Examiner's additional comments with respect to claims 3, 4, 21 and 24-27 do not cure the argued fundamental deficiencies of Kuwano et al. Applicants respectfully solicit withdrawal of the rejection of claims 3, 4, 21 and 24-27.

New Claim 28.

New claim 28 recites all the limitation recited in claim 20. Therefore, for the reasons set forth above, claim 28 is patentable. Applicants solicit favorable consideration of claim 28.

35. U.S.C. §103(c).

Applicants note that the present Application and Kuwano et al., cited as a §102(e) reference, were commonly owned by Matsushita Electric Industrial Co., Ltd. at the time the invention of the present Application was made. Therefore, Kuwano et al. cannot be considered when determining whether Applicants' invention is obvious under 35 U.S.C. § 103 in subsequent examination.

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Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Recognition under 37 C.F.R. §10.9(b)

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